

REMARKS**Status of Pending Claims**

Claims 15-22 remain pending.

35 U.S.C. 103(a) rejections

- (1) Claims 15, 16, 18-20 and 22 were rejected as being unpatentable over Ansmann (U.S. Patent 4,735,742) in view of Pottier (FR 1 427 366).

Ansmann is used as the primary reference and the applicants would also add to the examiner's characterization that within the context of the Ansmann invention there is a specific weight ratio relationship between the palmitic-stearic acid mixtures (relating to emulsifying power) which is disclosed by Ansmann and this relationship serves to reduce the "degrees of freedom" by which the examiner may elect to interpret the teachings of this reference and its eligibility to be combined with additional references.

The examiner acknowledges that Ansmann does not teach glycerol stearate citrate.

Pottier discloses example compositions XI and XII which contain glycerol stearate citrate and cetyl alcohol (it is presumed that this is the basis for applying Pottier as this reference consists of only 6 pages not 12 as indicated by the examiner). However, Pottier lacks any teaching as to the presence or effect of palmitic-stearic acid mixtures or that the Pottier compositions have any effect on improving emulsifying power as in the Ansmann reference.

Moreover, Pottier is being relied upon by the examiner for additional teachings which heretofore in the prosecution history have not been asserted. From the examiner's office action it was written that "Soap is taught as promoting epidermal dryness, roughness, cracking and other detrimental effects. Exemplified is an oil-in-water emulsion comprising glycerol stearate citrate, *wherein glyceryl stearyl citrate suppresses the harmful influence of soap. Palmitic acid, stearic acid, and glycerol stearate citrate are taught as interchangeable emulsifiers. See page 3-5 and 12.*" (bold and italics added by author)

As the Pottier reference is in French, it is requested that the specific passages which makes these assertions be identified in the next office action.

However, even if Pottier did teach what the examiner asserted, there still would be no motivation or suggestion to combine the references as indicated by the examiner to arrive at the applicants' invention.

While the reason for combining the references does not have to be related to the applicants intended use, there still must be a suggestion to combine the references when viewing the applicants invention and the prior art as a whole and that there would be a reasonable expectation of success for making the combination.

The key inventive concepts of the Ansmann (palmitic-stearic acid ratio control to enhance emulsifying power) and Pottier (use of glyceryl stearyl citrate to suppress harmful influence of

soap - assuming examiner's characterization is correct) inventions appear to be unrelated and as such one of ordinary skill in the art would not be directed to combining the references in the manner suggested by the examiner. "...Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention." see *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546, 48 USPQ2d 1321, 1329 (Fed. Cir. 1998).

As Ansmann requires a specific ratio of palmitic acid-stearic acid, the examiner is also presuming that the applicants' invention also contains these components in addition to their own claimed components. There is no teaching or suggestion from the prior art that such a combination would produce the enhancements in emulsifying power as disclosed in Ansmann or that the oil-in-water emulsion structure would be maintained, i.e. there is no reasonable expectation of success for making the modifications suggested by the examiner.

Lastly, the examiner recites *In re Aller* in order to support her holding that the 1:1 ratio of claim 18 would have been obvious. However, if the examiner were to review where the *Aller* decision is cited in the MPEP, it would be seen that application of *Aller* is conditional. The next paragraph in the discussion of "Optimization of Ranges" is MPEP 2144.05 section II (Optimization of Ranges) which states: "A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977)."

None of the cited references makes this recognition of the ratio between glycerol stearate citrate and cetylstearyl alcohol being a results effective variable.

With regard to claims 19-22, the examiner is reminded that the burden of showing inherency lies initially with the examiner. The prior art references relied upon by the examiner never show the use of a composition comprising of a combination of glycerol/tocopheryl acetate, glycerol stearate citrate and cetylstearyl alcohol.

Even if *in arguendo* the prior art references rendered the composition obvious, the means by which the examiner achieves this holding requires the combination of compositions which contain a great number of additional components (e.g. combining example 7 of Ansmann with example 12 of Pottier would result in a composition which contains not only the applicants' recited components but also the inclusion of 15 additional ingredients - it is unclear that such a combination would produce the applicants' claimed method of reducing stickiness and would certainly not be viewed as being an inherent property).

If the examiner is attempting to rely on the selected components of the applicants' emulsion to establish inherency with regard to the intended method of use, the examiner is referred to the quotation from *ATD Corp. v. Lydall Inc.* above. Moreover, MPEP 2112 (Requirements of Rejection Based on Inherency; Burden of Proof) states "**The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.** *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).....To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.*" *In re Robertson*, 169 F.3d 743, 745, 49

USPQ2d 1949, 1950-51 (Fed. Cir. 1999), see also *Mentor H/S, Inc. v. Medical Device Alliance, Inc. (Mentor II)*, 244 F.3d 1365, 58 USPQ2d 1321 (Fed. Cir. 2001) and *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) – bold and italics added by author for emphasis.

For any of the reasons cited above, the examiner would be justified in withdrawing the rejection of the claims over the above cited prior art.

- (2) Claims 17 and 21 were rejected as being unpatentable over Ansmann, *supra*, in view of Pottier, *supra*, and further in view of Wallat et al. (DE 3 820 693).

The applicants' comments with regard to Ansmann and Pottier made above are considered to be repeated here. As it appears that Wallat et al. is relied upon for the teachings of the use of tocopheryl acetate, the combination of references does not remedy the deficiencies of the Ansmann and Pottier references. Moreover, when considering the Wallat et al. reference as a whole, it would require an even further straining of motivation and reasonable expectation of success in order to combine their teachings with that of Ansmann and Pottier.

Closing

Applicants also believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Respectfully submitted,

Norris, McLaughlin & Marcus, P.A.

By: Howard C. Lee
Howard C. Lee
Reg. No. 48,104

220 East 42nd Street
30th Floor
New York, New York 10017
(212) 808-0700